

This Page Is Inserted by IFW Operations  
and is not a part of the Official Record

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning documents *will not* correct images,  
please do not report the images to the  
Image Problem Mailbox.**



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,599	02/01/2001	Kenneth F. Buechler	071949-2404	9314

30542 7590 03/13/2003

FOLEY & LARDNER  
P.O. BOX 80278  
SAN DIEGO, CA 92138-0278

EXAMINER

EPPERSON, JON D

ART UNIT	PAPER NUMBER
----------	--------------

1639

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b> <i>File Copy</i>	Application No.		Applicant(s)	
	09/776,599		BUECHLER ET AL.	
	Examiner		Art Unit	
	Jon D Epperson		1639	

-- The MAILING/DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 30-46 is/are pending in the application.
- 4a) Of the above claim(s) 32-44 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30,31,42 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

**Please note:** The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1639**.

### *Status of the Application*

1. Receipt is acknowledged of a Response to a Restriction Requirement, which was dated on December 2, 2002 (Paper No. 8).

### *Priority Claims*

2. Applicant's claim for domestic priority under 35 U.S.C. 120 and/or 119(e) is acknowledged. However, applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 and/or 119(e) as follows:

Applicant claims that the instant application is "a continuation in part of U.S. Patent Application No. 08/409,298 (pending), which is a continuation in part of U.S. Patent Application No. 08/274,534, filed July 12, 1994 (abandoned), and of U.S. Patent Application No. 08/138,708, filed October 18, 1993 (abandoned), and of U.S. Patent Application No. 08/126,367, filed September 24, 1993 (abandoned), and of U.S. Patent Application No. 08/311,098, issued as U.S. Patent No. 5,763,189 on June 9, 1998, and of U.S. Patent Application No. 08/409,825, filed March 23, 1995 (abandoned); and a continuation in part of U.S. Patent Application No. 09/066,255 (pending), which is a continuation of U.S. Patent Application No. 08/620,597, which issued as U.S. Patent No. 5,824,799 on October 20, 1998, which is a continuation in part of U.S. Patent Application No. 08/274,534, filed July 12, 1994 (abandoned), and of U.S. Patent

Art Unit: 1639

Application No. 08/311,098, issued as U.S. Patent No. 5,763,189 on June 9, 1998, and U.S. Patent Application No. 08/409,825, filed March 23, 1995 (abandoned); from each of which priority is claimed, and each of which are hereby incorporated by reference herein" (see Specification, page 1).

However, the Examiner cannot find adequate support under 35 U.S.C. 112 for the silicon phthalocyanine bis(dimethylhexylvinylsilyloxy) compound referred to in claims 30-46 in any priority documents referenced above other than U.S. Patent Application 08/409,398 (now U.S. Patent 6,251,687) (Date of Filing is March 23, 1995). Note that a broad generic disclosure is not sufficient support for a specific entity within the class. Accordingly, applicants' 35 USC 120 and/or 119(e) priority claim is hereby denied; and for purposes of prior art claims 30-46 are afforded the filing date of March 23, 1995 because the claims are deemed to be supported only by U.S. Patent Application 08/409,398 (now U.S. Patent 6,251,687), which was filed on March 23, 1995. If applicant believes this is in error, the Examiner asks that applicant point to the support for phthalocyanine bis(dimethylhexylvinylsilyloxy) in each of applications wherein priority is claimed.

Furthermore, Applicant's claim that the present application is a "continuation" of 08/620,597 appears to be incorrect. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Art Unit: 1639

The present application (09/776,599 filed February 1, 2001) discloses and claims "new matter" (e.g., silicon phthalocyanine bis(dimethylhexylvinylsilyloxy) not present in the parent application (e.g., 08/620,597) to which priority as a "continuation" is claimed. Accordingly, applicant's 35 USC 120 priority claim is hereby denied; and for purposes of prior art claims 30-46 are afforded the filing date of **March 23, 1995** for purposes of prior art (see above).

### *Status of the Claims*

3. Claims 30-46 are pending in the present application.

4. Applicant's response to the Restriction and/or Election of Species requirements in Paper No. 8 is acknowledged (Applicants elected Group I, claims 30-24 and 45-46 with traverse) and claims 43 and 44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim (see below i.e., *Response to Restriction and/or Election of Species*).

5. Please note: Applicants' elected species (compounds in claim 42 and latex, see Paper No. 8, pages 2-3) were found in the art, see rejections below. Applicant is reminded of MPEP § 803.02 with respect to species elections:

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-

Art Unit: 1639

type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

6. Claims 32-41 and 46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper No. 6 (see below i.e., *Response to Restriction and/or Election of Species*).

7. Therefore, claims 30-31, 42 and 45 are examined on the merits in this action.

***Response to Restriction and/or Election of Species***

8. Applicant's election of Group I (claims 30-42 and 45-46) with traverse in Paper No. 8 is acknowledged.

9. The traversal is on the ground(s) that "the Examiner is incorrect that an undue search burden is imposed if the claims of Groups II and III are included with those of elected Group I. In particular, the Examiner is incorrect that each of the foregoing groups "would require completely different searches ... In dependent claim 30 refers to a fluorescent particle comprising two compounds selected from specified groups. Because the claim is written in open form, the fluorescent particle of claim 30 does not exclude additional unspecified components. MPEP §2111.03. Claims 43 and 44, which the Examiner seeks to restrict from Group I, depend from claim 30, and simply recite a fluorescent particle that includes such an additional component (an

Art Unit: 1639

antibody or a nucleic acid).” Applicant further argues that “claim 30 is thus a linking claim which, if allowable must result in withdrawal of a restriction requirement as to the linked inventions. MPEP § 809.03. Moreover, because claims 43 and 44 are species within the scope of the generic claim 30, any complete search of Group I must include a search for Groups II and III as well. Conversely, any search of Group I that would not include the subject matter of Groups II and III would not be a “thorough search of the art.” MPEP §904.02.” Finally applicant argues “Because the search for Group I necessarily includes a search for Groups II and III, Applicants respectfully submit no undue search burden is imposed if the claims of Groups II and III are included with those of elected Group I.”

10. These arguments were fully considered but were not found persuasive. As stated in Paper No. 7, the inventions of Groups I-III “represent separate and patentably distinct products because they differ in respect to their properties, their use and the synthetic methodology for making them. For example, Group III is drawn to a fluorescent particle that “further comprises a nucleic acid”, which requires different reagents and/or materials than Groups I and II (i.e., requires a nucleic acid). Likewise, Group II is drawn to a fluorescent particle that “further comprises an antibody”, which requires different reagents and/or materials than Groups I and III (i.e., requires an antibody). Therefore, art anticipating or rendering obvious each of the above-identified groups respectively would not necessarily anticipate or render obvious another group, because they are drawn to different inventions that have different distinguishing features and/or characteristics. Consequently, Groups I-III have different issues regarding patentability and enablement and represent patentably distinct subject matter” (see Paper No. 7, paragraph 4).



The fact that applicant uses “open language” i.e., the word “comprising” does not render the patentably distinct products any less distinct or burdensome to search. As stated by applicants, the Examiner must show according to MPEP § 803 “(A) The inventions must be independent or distinct as claimed; and (B) There must be a serious burden on the examiner if restriction is required.” Here, the products in question are classified in completely different classes and subclasses (see Paper No. 7, paragraph 2) and, as already stated on the record, would require separate burdensome searches.

11. Applicant’s election of species in Paper No. 8 is also acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election of species has also been treated as an election without traverse (MPEP § 818.03(a)).

12. As a result, the restriction requirement and/or election of species is still deemed proper and is therefore made FINAL.

#### ***Information Disclosure Statement***

13. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98 (b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, “the list may not be incorporated into the specification but must be submitted in a separate paper.” Therefore, unless the references have been cited by the examiner on the form PTO-892, they have not been considered.

14. The references listed on applicant's PTO-1449 form have been considered by the Examiner. A copy of the form is attached to this Office Action.

*Specification*

15. The oath or declaration is defective. A new oath or declaration is required for the following reasons:

Where a copy of the oath or declaration from a prior application was filed in a continuation or divisional application, if the examiner determines that new matter is present relative to the prior application, the examiner should so notify the applicant in the next Office action (preferably the first Office action). The examiner should require: (A) a new oath or declaration along with the surcharge set forth in 37 CFR 1.16(e); and (B) that the application be redesignated as a continuation-in-part. See MPEP § 201.06(c).

Here, the Examiner submits that the present application is a continuation-in-part of 08/620,597 because it contains new matter e.g., discloses silicon phthalocyanine bis(dimethylhexylvinylsilyloxiide) that is not present in the parent application.

16. Furthermore, an application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). However, this application fails to properly reference the prior application(s) to which it claims priority. For example, the present application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Here, the current application cannot be a CIP of 08/138,708 and 08/311,098 because the applications were not co-pending with the current application. In

Art Unit: 1639

addition, applicants must update the status of the priority documents e.g., 08/409,298 is not "pending" as indicated by applicants i.e., it is now U.S. Patent 6,251,687. Applicants are requested to address the numerous errors of this type.

17. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claims Rejections - 35 U.S.C. 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

18. Claims 30-31 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Buechler et al (U.S. Patent No. 6,238,931) (Please note that U.S. Patent No. 6,238,931 has different "assignee" than the current application and claims priority to 08/138,708 filed **Oct. 18, 1993**, now abandoned, and of application Ser. No. 08/126,367 filed **Sep. 24, 1993**).

For *claims 30-31 and 45*, Buechler et al (see entire document) disclose fluorescent "latex" particles that contain as a first compound silicon phthalocyanine

Art Unit: 1639

bis(trihexylsilyloxy) wherein the particles have a size that is (see Buechler et al, Examples 2, 10, 13, which anticipates claims 30-31 and 45.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sounik et al (EPO 0391284 A1) (Date of Publication is **October 10, 1990**) and Wheeler et al (Wheeler, B. L.; Nagasubramanian, G.; Bard, A. J.; Schechtman, L. A.; Dininny, D. R.; Kenney, M. E. "A Silicon Phthalocyanine and a Silicon Naphthalocyanine: Synthesis, Electrochemistry, and Eletrogenerated Chemiluminescence" *J. Am. Chem. Soc.* **1984**, *106*, 7404-7410).

For *claim 30*, Sounik et al (see entire document) teaches particles that comprise mixtures of substituted and/or unsubstituted phthalocyanine, naphthalocyanine and anthracyanine structures wherein the metal can be silica (see Sounik et al, page, 2, last paragraph; see also claims, especially claims 1-5 and 9).

The prior art teachings of Sounik et al differ from the claimed invention as follows:

For *claim 30*, Sounik et al is deficient in that it does not specifically teach the use of either “dimethylhexylvinylsilyloxy” or “trihexylsilyloxy” as the ligands to the Silicon metal. Sounik teaches that the ligands to the metal can be “hydrogen, halogen or an aliphatic, alicyclic or aromatic substituent containing 1-12 carbon atoms”, which would encompass applicants ligands; however, Sounik et al only provides the specific ligand of “dimethyloctadecylsiloxy.”

However, Wheeler et al teaches the following limitations that are deficient in Sounik et al:

For *claim 30*, Wheeler et al (see entire document) teaches the use of a “trihexylsilyloxy” as a ligand for both silicon phthalocyanine and silicon naphthalocyanine (see Wheeler et al, abstract; see also page 7404, paragraph 1; see also figure 1).

It would have been obvious to one skilled in the art at the time the invention was made to make a particle of mixed silicon phthalocyanine, naphthalocyanine and/or anthracyanine dyes as taught by Sounik et al with the silicon phthalocyanine

bis(trihexylsilyloxy) and silicon naphthalocyanine bis(trihexylsilyloxy) compounds as disclosed by Wheeler et al because the compounds disclosed by Wheeler et al would fall within the genus of compounds that are claimed by Sounik et al (see Sounik et al, claim 9 stating that the ligand is “hydrogen, halogen or an aliphatic, alicyclic or aromatic substituent containing 1-12 carbon atoms”, which would encompass the “trihexylsilyloxy” ligands disclosed by Wheeler et al i.e., six carbons is within 1-12 carbons). Furthermore, one of ordinary skill in the art would have been motivated to use the silicon phthalocyanine bis(trihexylsilyloxy) and silicon naphthalocyanine bis(trihexylsilyloxy) compounds as taught by Wheeler et al because according to Wheeler et al “[t]he presence of the trialkylsiloxy groups on the central Si atom leads to relatively high solubility in these compounds and permits studies of solutions of them at the millimolar level” (see Wheeler et al, sentence bridging pages 7404-7405). Furthermore, Wheeler et al shows that the compound exhibit favorable optical properties that are required by the tetrazaporphin “dye” mixture of Sounik et al (see Wheeler et al, page 7409, “Absorption and Fluorescence” section; see also conclusion). Furthermore, one of ordinary skill in the art would have reasonably expected to be successful because Wheeler et al further shows states that the compounds “show high thermal and chemical stability and interesting optical ... properties (see Wheeler et al, page 7404, paragraph 1) and also show “intense absorption around 650-700 nm for SiPc(OR)<sub>2</sub>, 600-650 nm for RO(SiPcO)<sub>2</sub>R, and 750-800 nm for SiNc(OR)<sub>2</sub>”, which corresponds to the range of absorption required by Sounik et al (see Sounik et al, page 3, lines 15-16, “[i]n another

Art Unit: 1639

ambodiment ... a mixture of tetrazoporphin dye consitutents ... exhibit light absopction over a spectrum range of about 660-860 nm”).

22. Claims 30-31 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al (Wheeler, B. L.; Nagasubramanian, G.; Bard, A. J.; Schechtman, L. A.; Dininny, D. R.; Kenney, M. E. “A Silicon Phthalocyanine and a Silicon Naphthalocyanine: Synthesis, Electrochemistry, and Eletrogenerated Chemiluminescene” *J. Am. Chem. Soc.* **1984**, *106*, 7404-7410) and Sounik et al (EPO 0391284 A1) (Date of Publication is **October 10, 1990**) and Vener et al (Vener, T. I.; Turchinskii, M. F.; Knorre, V. D.; Lukin, Y. V.; Shcherbo, S. N.; Zubov, V. P.; Sverdlov, E. D. “A novel approach to nonradioactive hybridization assay of nucleic acids sing stained latex particles” *Analytical Biochemistry* **1991**, *198*(2), 308-311).

For *claim 30*, the combined teachings of Wheeler et al and Sounik et al teach all the limitations stated in the 35 U.S.C. 103(a) rejection above (incorporated in its entirety herein by reference), which renders obvious claim 30.

The combined prior art teachings of Wheeler et al and Sounik et al differ from the claimed invention as follows:

For *claims 31 and 45*, the combined prior art teachings of Wheeler et al and Sounik et al differ from the claimed invention by not specifically reciting the use of a “latex” particle that are “between 0.1 nm and 5000 nm”.

However, Vener et al teaches the following limitations that are deficient in Sounik et al and Wheeler et al:

For *claim 31 and 45*, Vener et al (see entire document) teaches that polyacrolein “latex particles” can be used to encapsulate dyes wherein the particle size falls between 0.1 nm and 5000 nm i.e., 1.8  $\mu$ m (see Vener et al, Materials and Methods Section, especially page 308, last paragraph; see also figure 1 and page 311, column 1, paragraph 2).

It would have been obvious to one skilled in the art at the time the invention was made to combine the references of Sounik et al and Wheeler et al with Vener et al because Vener et al requires the incorporation of a “dye” in “latex particles” for their hybridization assay and the combined teachings of Sounik et al and Wheeler et al put for dyes that are “stable” and have favorable spectroscopic and solubility properties. Furthermore, one of ordinary skill in the art would have been motivated to use the “dyes” disclosed by the combined teachings of Sounik et al and Wheeler et al with the “latex particles” of Vener et al because the combined teachings of Sounik et al and Wheeler et al teach that these dyes are highly water soluble, stable and possess favorable fluorescent properties (see 35 U.S.C. § 103(a) rejection, above). Furthermore, one of ordinary skill in the art would have reasonably expected to be successful because the combined teachings of Sounik et al and Wheeler et al teaches that their “phthalocyanine dyes” can be combined with polymers such that would be used to make latex (see Sounik et al, page 2, lines 48-51).

### ***Double Patenting***

23. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible



Art Unit: 1639

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1639

24. Claims 30-31, 42 and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-136 of U.S. Patent No. 6,251,687 (especially claim 104). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1986). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 30-31, 42 and 45 are generic to all that is recited in claim 104 of U.S. Patent No. 6,251,687. That is, claim 104 of U.S. Patent No. 6,251,687 falls entirely within the scope of claims 30-31, 42 and 45 or, in other words, claims 30-31, 42 and 45 are anticipated by claim 104 of U.S. Patent No. 6,251,687. First, claim 104 of '687 discloses silicon phthalocyanine bis(dimethylhexylvinylsilyloxy) and silicon[di(1,6-diphenylnaphthalocyanine)diphthalocyanine bis(dimethylhexylvinylsilyloxy) (note claim 104 recites claim 100 using the "or" phraseology), which falls entirely within the scope of claims 30-31, 42 and 45 because these two compounds are recited in claims 30-31, 42 and 45 or depend on claims that recite these two compounds. Second, claim 104 of '687 recites the use of a latex particle, which falls entirely within the scope of claims 30-31, 42 and 45 because claims 30-31, 42 and 45 either explicitly recite the use of latex (i.e., claim 31) or use "comprising" terminology that would include latex. Finally, claim 104 of '687 also falls entirely within the scope of claim 45 because the specification defines the claimed particles as having a "[p]referred particle sizes range from about 0.1 nm to 5000 nm" (see U.S. Patent No. 6,251,687,

Art Unit: 1639

specification, "Incorporation of Dyes into Particles" Section, second paragraph). Please note that that "those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent" (MPEP § 804).

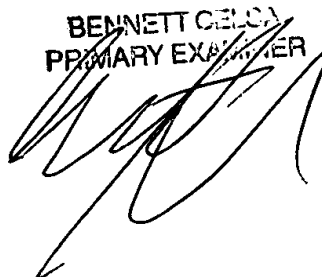
***Contact Information***

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (703) 308-2423. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (703) 306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2439.

Jon D. Epperson, Ph.D.  
March 3, 2003

BENNETT CELSA  
PRIMARY EXAMINER  


Application/Control Number: 09/776,599  
Art Unit: 1639